

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCE

In Re Application of : Frank Forrest Humbles

Serial No.: 10/698,205

Filing Date: 31 October 2003

Invention: SURGICAL ARM POSITIONING PAD

Examiner: Mayo, Tara L.
Art Unit: 3671
Appeal #:

Board of Patent Appeals and Interference
United States Patent and Trademark Office
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REPLY BRIEF OF THE APPELLANT

This is a Reply Brief to an Examiner's Answer. The Examiner's Answer was filed on
November 24, 2006.

ARGUMENT

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Reply to Rejections

The Applicant/Appellant will not repeat the arguments made in the original Brief in response to the Examiner's Final Office Action in this Reply Brief. In the Examiner's answering Brief, the Examiner repeated her Office Action of December 5, 2005 word-for-word beginning on page 3 to the bottom of page 9 of her answer. Because the examiner has repeated the Office Action from which the Applicant is appealing, the Applicant will not respond any further to these grounds of rejection. Applicant incorporates by reference herein those sections the Applicant's Brief dealing with the repeated grounds for final rejection as set out in the December 5, 2005 Office Action.

Reply to the Examiner's Arguments

The Examiner's argument does not follow the Applicant's claim structure, nor does it to respond point-by-point to the Applicant's Brief filed in this case. Consequently, Applicant's reply is necessarily piecemeal corresponding to the organization of the Examiner's answer. With those limitations in mind, the Applicant wishes to make the following points in reply to the Examiner's argument.

In the Argument section of the Examiner's Answer, the Examiner begins with Claim 1. There the Examiner recites well-known case law that holds an apparatus must be distinguished from the prior art in terms of structure rather than function. In the Applicant's Brief, the Applicant pointed out, with specific references both to the Applicant's disclosure and to the Ogburn '293 reference, in what ways the Applicant's disclosed invention was structurally different from the Ogburn '293 reference. The Examiner did not respond to the specific structural differences highlighted by the Applicant's argument, but rather simply concluded: "Moreover, the Examiner contends that anything that covers the arm inherently protects the arm." The Applicant wonders if the Examiner seriously contends that a sheet of tissue paper, a plaster cast, a section of barbed wire fence, or a length of poison ivy vine, which all in some sense could be used to cover the arm, inherently protect the arm. If so, the Examiner would need not bother with the Ogburn '293 reference but could simply cite an Arrow shirt, 15-1/2 collar, 33 sleeve, as prior art to the Applicant's invention and be done with any pesky need for prior art patents.

The Examiner does not point to anything in any of the prior art references used by the Examiner that would imply or suggest the combinations used by the Examiner to hold the Applicant's claims obvious. In the Examiner's argument, she correctly states the law that make a combination it is "...necessary to ascertain whether there is any suggestion or motivation in the prior art to make the selection" (Examiner's argument, bottom of page 11, top of page 12). In no way does the Examiner respond to the Applicant's detailed explanation of why the Examiner's prior art references do not disclose or teach why a soft cushion pad should be individually wrapped around a patient's arm to protect that patient's arm from outside forces. In the Answer, the Examiner failed to point to anything in the prior art references that suggests or motivate the

combinations made by the Examiner. These combinations were motivated only by the disclosure of the Applicant's invention to the Examiner. Once shown the need for a device disclosed and claimed by the Applicant, the Examiner combed through the prior art to find individual items to combine them in a way unsuggested by the art itself to arrive at the Applicant's invention. Where the prior art was deficient in some fashion regarding a claim in the Applicant's invention, the Examiner remedied that deficiency by stating that the needed claim limitation was "inherent" in the prior art. The Applicant has already noted one instance in this Reply. Another example is where the Examiner states, without any factual support, that fleece pads are radiolucent (Examiner's Brief, page 11).

The Examiner is critical of the Applicant's use of the term "hard" in describing the cuffs (16 and 17) of the Ogburn '293 patent. Ogburn describes the cuffs (16 and 17) as "heavy, relatively stiff leather" (Ogburn, Column 2, lines 1-3). The Applicant chose to use the shorthand description of "hard" instead of "heavy, stiff leather." This is viewed as taking a liberty then the Applicant would simply request that the Board substitute the terms "heavy, stiff leather" for the term "hard" in the Applicant's Brief. As was noted in this regard that the Ogburn patent felt it necessary to disclose padding (19) underneath the cuffs to prevent injury to a patient from those heavy, stiff leather cuffs.

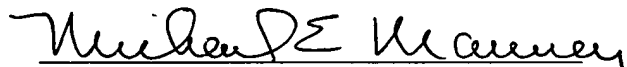
Regarding the section 112 second paragraph rejection for use of the term "easily" or the term "quickly," Applicant has responded to this rejection in his original Brief. In the Answer, the Examiner states that the Applicant is self-serving in concluding what the terms "easily" and "quickly" mean. The Examiner states the Applicant is using the specification to impart claims limitations not otherwise present in the claims themselves. First, the Applicant is entitled to be his own lexicographer. Here the terms "easily" and "quickly" are used in their everyday meanings. As far as there might be any uncertainty in their meaning, the specification may be referred to ascertain the meaning of the limitations imposed by the terms "easily" and "quickly." The specification here, as was argued in the original Brief, fully and accurately disclose the meaning of those terms, if any disclosure is required beyond the ordinary dictionary meaning of those terms. Of course, the Applicant is being self-serving in his Brief. That is the point of a Brief - to serve the Applicant's interest. However, the Applicant has done so within the clear bounds of patent law and

by carefully referencing either the Applicant's own disclosure or using outside references such as a dictionary. That is how the meaning of terms in a patent claim is determined, by the ordinary meaning of the term and, if necessary, by looking to the specification. There is nothing indefinite in Applicant's claims because of the use of the terms "easily" or "quickly" and the Board should so find.

CONCLUSION

The Applicant has fully replied to the Examiner's argument. It is believed that all claims are in a condition for allowance and the same is requested.

This the 9 day of JAN., 2007.


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CERTIFICATE OF SERVICE

I, Michael E. Mauney, do hereby certify that a copy of the foregoing Reply Brief of the Appellant in:

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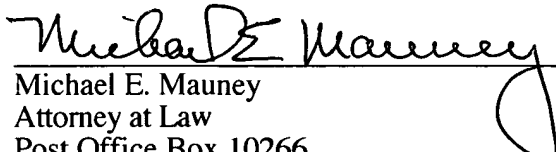
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This the 9 day of June, 2007.



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